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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,655	03/17/2004	Takao Inoue	50024-025	1697
7590 McDERMOTT, WILL & EMERY 600 13th Street, N.W. Washington, DC 20005-3096			EXAMINER WILLS, MONTQUE M	
			ART UNIT 1795	PAPER NUMBER
			MAIL DATE 06/20/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/801,655

Applicant(s)

INOUE ET AL.

Examiner

Monique M. Wills

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-9 and 11-18 is/are pending in the application.
- 4a) Of the above claim(s) 13-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-9,11 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This Office Action is responsive to the Amendment filed January 2, 2008. The claim objection of claims 4 & 10 under 37 CFR 1.75(c) is withdrawn. Claims 1-4 & 7-10 stand rejected under 35 U.S.C. 102(b) as being anticipated by Peled et al. U.S. Pat. 5,591,543. Claims 5-6 & 11-12 are rejected under 35 U.S.C. 103(a) , *under new grounds* as being unpatentable over Peled et al. U.S. Pat. 5,591,543 in view of Loch et al. U.S. Pat. 6,171,723.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 & 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Peled et al. U.S. Pat. 5,591,543.

With respect to claim 1, Peled teaches a non-aqueous electrolyte secondary battery comprising: a negative electrode, positive electrode and a non-aqueous electrolyte, wherein the cathode contains an oxide containing magnesium substituted for part of lithium. The limitation with respect to the rock-salt structure is considered an inherent property of the prior art set forth, because the Peled teaches the identical compounds set forth by applicant. In accordance with MPEP 2112.01, "[p]roducts of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). In the instant case, the rock-salt structure is necessarily present because the lithium compounds are the same.

With respect to claims 2, 3, 8 & 9, the cathode compound is $\text{Li}_x\text{M}_{x/2}\text{CoO}_2$ where x is between 0.4 to 1 and M is magnesium. See the Abstract and col. 2, lines 29-40. With respect to claims 6 & 7, the magnesium electrochemically substitutes part of the lithium in the oxide. See the Abstract and col. 2, lines 29-40.

Therefore, the instant claims are anticipated by Peled.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-6 & 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peled et al. U.S. Pat. 5,591,543 in view of Loch et al. U.S. Pat. 6,171,723.

Peled teaches an electrochemical cell as described in the rejection recited hereinabove. Peled teaches dimethyl carbonate and ethylene carbonate electrolyte solvents (col. 3, lines 45-55).

Peled does not teach a non-aqueous electrolyte including an imide salt with a magnesium cation.

However, Loch teaches that it is well known in the art to employ imide salts in ethylene carbonate and dimethyl carbonate electrolyte mixtures.

Peled and Loch are analogous art, because they are from the same field of endeavor namely, fabricating lithium secondary cells with carbonate electrolyte solvents. See Example 19.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to employ the imide salt of Loch, in the electrolyte of Peled, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the same intended purpose. In re Leshin, 125 USPQ 416.

With respect to the magnesium cation, it would have been obvious to one of ordinary skill in the art to substitute magnesium for lithium and other cations in the imide salt, as part of routine experimentation to determine the highest level of ion conductivity in the salt.

Response to Arguments

With respect to the rejection of claims 1-4 and 7-10 under Peled, Applicant traverses the rejection asserting that the reference does not disclose an oxide containing magnesium electrochemically substituted for part of lithium. The Applicant points to Peled at column 4, lines 3-6, where a portion of MO or MCO_3 remain to serve as a desiccant buffer in the electrode. This argument is not persuasive, as Peled teaches $\text{Li}_x\text{M}_{x/2}\text{CoO}_2$ where x is between 0.4 to 1 and M is magnesium. The compound is a lithium oxide with magnesium and cobalt electrochemically substituted to form the identical compound set forth by Applicant. Therefore, the rejection is maintained.

With respect to the rejection of claims 5, 6, 11 and 12, the Applicants arguments are persuasive and the rejection of said claims has been made on new grounds.

Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Monique Wills whose telephone number is (571)

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272-1309. The Examiner can normally be reached on Monday-Friday from 8:30am to 5:00 pm.

If attempts to reach Examiner by telephone are unsuccessful, the Examiner's supervisor, Patrick Ryan, may be reached at 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Monique M Wills/
Examiner, Art Unit 1795

/PATRICK RYAN/
Supervisory Patent Examiner, Art Unit 1795

Application Number**Application/Control No.**

10/801,655

Examiner

Monique M. Wills

**Applicant(s)/Patent under
Reexamination**

INOUE ET AL.

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